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Attorneys For Defendants, Spencer Gifts, LLC, Spencer Gifts Holding, LLC and Spencer Gifts Online, LLC.

**UNITED STATES DISTRICT COURT**  
**SOUTHERN DISTRICT OF CALIFORNIA**

|  |   |                                 |
|--|---|---------------------------------|
| TUNI & G, a California General Partnership | ) | Case No. 08 CV 0410 BTM JMA     |
|  | ) |                                 |
| Plaintiffs,                                | ) | <b>ANSWER TO COMPLAINT</b>      |
|  | ) | <b>WITH COUNTERCLAIM OF</b>     |
| v.   | ) | <b>DEFENDANT SPENCER GIFTS,</b> |
|  | ) | <b>LLC, SPENCER GIFTS</b>       |
| SPENCER GIFTS, LLC, a Delaware Limited     | ) | <b>HOLDING, LLC and SPENCER</b> |
| Liability Company; SPENCER GIFTS           | ) | <b>GIFTS ONLINE, LLC</b>        |
| HOLDING, LLC, a Delaware Limited Liability | ) |                                 |
| Company; SPENCER GIFTS ONLINE, LLC, a      | ) | <b>[DEMAND FOR JURY TRIAL]</b>  |
| Delaware Limited Liability Company; and    | ) |                                 |
| DOES 1 through 10, inclusive,              | ) |                                 |
|  | ) |                                 |
| Defendants.                                | ) |                                 |

Spencer Gifts, LLC, Spencer Gifts Holding, LLC and Spencer Gifts Online, LLC  
 ("Spencer") by its undersigned counsel answers the Complaint as follows:

1. Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number one (1) of the Complaint and so denies the same and leaves Tuni & G ("Tuni") to its proofs.
2. Admitted.
3. Denied.
4. Admitted.
5. Spencer admits that the court has jurisdiction over the subject matter of the action.

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6. Spencer admits that venue is proper in this district.

7. To the extent understood, denied.

8. To the extent understood, denied.

9. Spencer is without knowledge or information, Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number nine (9) of the Complaint and so denies the same and leaves Tuni to its proofs, except that Spencer admits that Tuni claims ownership of U.S. Trademark Registration No. 3158551 and the mark thereof for the goods identified therein, which registration is the subject of a petition for cancellation filed March 12, 2008.

10. Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number 10 of the Complaint and so denies the same and leaves Tuni to its proofs.

11. Denied.

12. Denied.

13. Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number 13 of the Complaint and so denies the same and leaves Tuni to its proofs.

14. Spencer denies that the slogan employed on the product it sells, as depicted in Exhibit 2 to the Complaint, is identical except for a spelling change to what Tuni alleges is a mark. Except to the extent expressly denied, Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number 14 of the Complaint and so denies the same and leaves Tuni to its proofs.

15. Spencer admits that it has refused to commit to discontinue sale of the products alleged to infringe, on the basis that it has a right to sell such products. Except to the extent admitted, the allegations of Paragraph number 15 of the Complaint are denied.

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16. Denied.

17. Denied.

18. Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number 18 of the Complaint and so denies the same and leaves Tuni to its proofs.

19. Denied.

20. Spencer incorporates by reference its responses to Paragraph numbers 1-19 of the Complaint.

21. Spencer admits that the registration cited by Tuni is a federal registration which is now subject to a petition for cancellation. Except to the extent admitted, Spencer is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of Paragraph number 21 of the Complaint and so denies the same and leaves Tuni to its proofs.

22. Denied.

23. Spencer admits that Tuni has not consented to its sale of the product alleged to infringe. Spencer admits that a federal registration is constructive notice of the registrant's claim to the exclusive right to use the mark as shown in the registration on the goods identified in the registration. Except to the extent admitted, the allegations of Paragraph number 23 of the Complaint are denied.

24. Denied.

25. Denied.

26. Spencer incorporates by reference its responses to Paragraph numbers 1-25 of the Complaint.

27. Denied.

28. Denied.

29. Spencer incorporates by reference its responses to Paragraph numbers 1-28 of the Complaint.

1 30. Denied.

2 31. Denied.

3 32. Denied.

4 **AFFIRMATIVE DEFENSE**

5 33. Tuni has no trademark rights in the ornamental phrase alleged to be  
6 its mark.

7 34. The phrase alleged to be a mark functions as ornamentation and is  
8 not source-indicating.

9 35. Spencer's use of the phrase on the product depicted in Exhibit A to  
10 the Complaint is a fair use of common language and not as a trademark and not infringing.

11 **COUNTERCLAIM**

12 36. This court has jurisdiction over the subject matter of this  
13 counterclaim pursuant to 15 USC 1119.

14 37. Tuni has asserted against Spencer the mark of Registration No.  
15 3158551 and said registration.

16 38. As set forth in the petition for cancellation attached as Exhibit 1, Tuni  
17 is not entitled to such registration on the grounds that the alleged mark is mere  
18 ornamentation, a commonplace slogan used as amusing decoration and derived from a  
19 third party's song, and is not capable of identifying source.

20 39. The alleged registration is subject to cancellation pursuant to 15 USC  
21 1052 and 1064.

22 **PRAYER FOR RELIEF**

23 WHEREFORE, Spencer prays:

24 1. that Tuni & G's complaint be dismissed, with prejudice;

25 2. that the court order the cancellation of Registration No. 1258551;

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3. that Spencer be awarded its fees and costs of this action pursuant to  
15 USC 1117 and such other relief as may be appropriate.

Dated: March 26, 2008

LAW OFFICES OF MICHELLE D. MITCHELL

By:



Michelle D. Mitchell  
Attorneys for Defendants

## **EXHIBIT 1**

Trademark Trial and Appeal Board Electronic Filing System. <http://estta.uspto.gov>ESTTA Tracking number: **ESTTA197864**Filing date: **03/12/2008**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

|                      |   |             |          |
|----------------------|---|-------------|----------|
| Name                 | Spencer Gifts, LLC  |             |          |
| Entity               | Limited Liability Company   | Citizenship | Delaware |
| Address              | 6826 Black Horse Pike<br>Egg Harbor Township, NJ 08234<br>UNITED STATES   |             |          |
| Attorney information | Roberta Jacobs-Meadway<br>Eckert Seamans Cherin & Mellott, LLC<br>50 South 16th Street 22nd Floor<br>Philadelphia, PA 19102<br>UNITED STATES<br>rjacobsmeadway@eckertseamans.com Phone:215-851-8522 |             |          |

**Registration Subject to Cancellation**

|                 |   |                   |            |
|-----------------|---|-------------------|------------|
| Registration No | 3158551   | Registration date | 10/17/2006 |
| Registrant      | Tuni & G<br>10755 F Scripps Poway Pkwy., Suite #515<br>San Diego, CA 92131<br>UNITED STATES |                   |            |

**Goods/Services Subject to Cancellation**

|  |
|--|
| Class 025. First Use: 2005/08/01 First Use In Commerce: 2005/10/25<br>All goods and services in the class are cancelled, namely: Adult, child and infant clothing, namely, hats, socks, tank tops, t-shirts, long sleeve shirts, short sleeve shirts, hooded shirts, sweat shirts, sweat pants, relaxed pants; women's clothing, namely maternity shirts; infant and toddler clothing, namely one-piece clothing |
|--|

**Grounds for Cancellation**

|   |                               |
|---|-------------------------------|
| The mark comprises matter that, as a whole, is functional | Trademark Act section 2(e)(5) |
|---|-------------------------------|

|             |   |
|-------------|---|
| Attachments | PETITION FOR CANCELLATION OF REGISTRATION 3158551 (M0641394).PDF ( 6 pages )(156696 bytes ) |
|-------------|---|

**Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                          |
|-----------|--------------------------|
| Signature | /Roberta Jacobs-Meadway/ |
| Name      | Roberta Jacobs-Meadway   |
| Date      | 03/12/2008               |



I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING  
TRANSMITTED ELECTRONICALLY TO THE COMMISSIONER FOR  
TRADEMARKS - <http://esta.uspto.gov/filing/type.isp>

By: Mary J. Rosenhofer  
DATE: March 12, 2008

BOX TTAB – FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                    |   |                            |
|--------------------|---|----------------------------|
| SPENCER GIFTS, LLC | : |                            |
|                    | : |                            |
| Petitioner,        | : |                            |
|                    | : |                            |
| v.                 | : | Cancellation No.           |
|                    | : | Registration No. 3,158,551 |
| TUNI & G           | : |                            |
|                    | : |                            |
| Respondent         | : |                            |

**PETITION FOR CANCELLATION**

Honorable Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

In the matter of Trademark Registration No. 3,158,551 issued October 17, 2006:

Spencer Gifts, LLC, a Delaware limited liability company with a place of  
business located at 6826 Black Horse Pike, Egg Harbor Township, New Jersey, 08234-4197  
("Spencer"), believes that it will be damaged by the above-identified registration issued for the  
goods therein identified and hereby petitions to cancel the registration of said trademark. The  
grounds for cancellation are as follows:

1. Tuni & G ("Tuni") has secured Registration No. 3,158,551 for DON'T  
YA WISH YOUR MOMMY WAS HOT LIKE MINE? as a trademark for adult, child and  
infant clothing as identified in said certificate of registration.

2. Spencer is and has for many years been engaged in the distribution and sale of novelty items and gifts, including t-shirts and hats and sweatshirts with humorous slogans and parodies of catch phrases having then-current popularity.

3. Spencer has offered for sale and sold the item depicted in Attachment A.

4. Tuni has objected to Spencer's use of the ornamental slogan on the item, namely: "Don't You Wish Your Mommy Was Hot Like Mine," alleging such use is an infringement of its rights in the alleged mark of the registration which is the subject of this Petition.

5. Tuni's alleged mark which is the subject of its registration is incapable of distinguishing Tuni's goods from the like goods of others, including Spencer. Tuni and others have used and use such slogans as ornamentation and to convey a non-trademark message in connection with the same and closely related products.

6. The slogan which Spencer has used which is the subject of Tuni's objection is derived from a song by the Pussycat Dolls, "Don't Cha (Wish Your Girlfriend Was Hot Like Me").

7. The slogan is one which has been in general use in diverse variations and is not associated exclusively with any one entity.

8. If Tuni is able to maintain its registration for the mark which is the subject of this Petition, Spencer and others would be damaged insofar as there would be a cloud on their ability to use and to continue to use such slogans as fun, ornamental designs.

9. The registration which is the subject of this Petition accords a *prima facie* exclusive right to Tuni to use the mark. Such registration is a source of damage and injury to

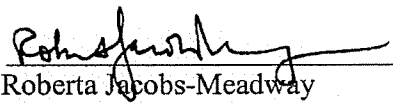
Spencer and others who use and have a right to use such common variations on popular catch phrases to amuse buyers and recipients having nothing to do with source identification.

WHEREFORE, Spencer Gifts, LLC prays that this Petition be sustained and that Registration No. 3,158,551 be cancelled.

Any additional fees in connection with this cancellation may also be charged to the credit card number used to file this petition and any overpayment may be credited to that account.

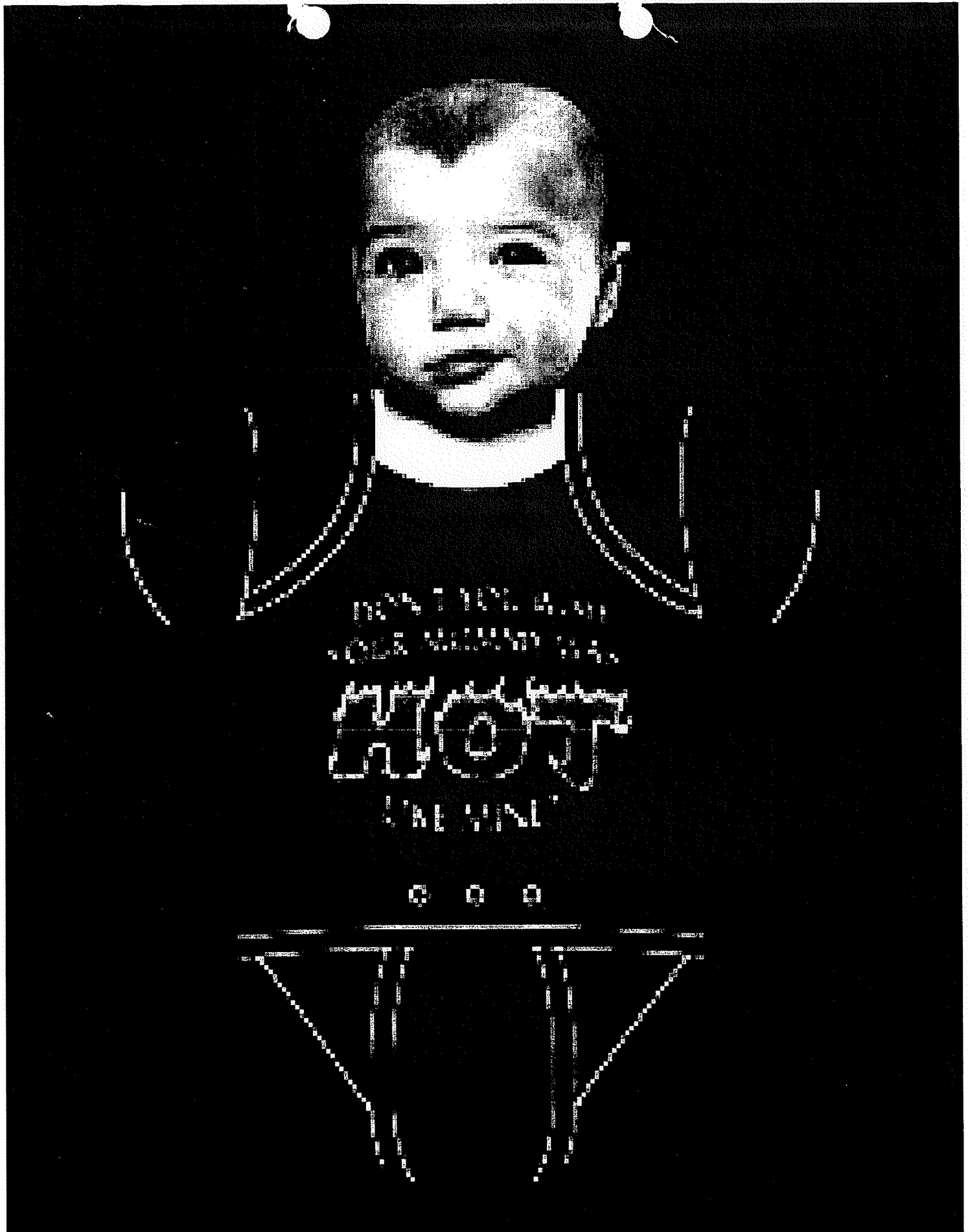
Date: March 12, 2008

Respectfully submitted,

By:   
\_\_\_\_\_  
Roberta Jacobs-Meadway  
Richard J. Peirce  
Eckert Seamans Cherin & Mellott, LLC  
Two Liberty Place  
50 South 16<sup>th</sup> Street, 22<sup>nd</sup> Floor  
Philadelphia, PA 19102  
Phone: 215-851-8522  
Fax: 215-851-8383  
rjacobsmeadway@eckertseamans.com

ATTORNEYS FOR PETITIONER

## **ATTACHMENT A**



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the attached Petition for Cancellation was served on counsel for Tuni & G on the dated listed below via facsimile and U.S. Mail:

Matthew A. Becker, Esquire  
The Law Office of Matthew A. Becker, P.C.  
1003 Isabella Avenue  
Coronado, CA 92118-2863  
Facsimile: 619-522-6763

Dated: March 12, 2008

Mary T. Boesenhofer  
Mary T. Boesenhofer